

REMARKS

Claims 1-20 are pending. By this amendment, claims 1, 2, 8, 16, 19, and 22 are amended. No new matter is introduced. Support for the amendments may be found at least in page 6, lines 3-14 and lines 21-22 of the specification. Reconsideration and issuance of a Notice of Allowance are respectfully requested in view of the preceding amendments and following remarks.

Claim Rejections Under 35 U.S.C. § 101

Claims 1-7, 16, 17, 19 and 20 stand rejected under 35 U.S.C. § 101 for reasons stated on page 2 of the Office Action. Specifically, claims 1-7, 16 and 17 are rejected because the claimed invention is directed to the defining of a data structure. Independent claims 1 and 16 have been amended to recite the hardware components that permit the data structure's functionality to be realized.

Claims 16 and 19 are rejected because the claimed invention "appears to be to an abstract idea rather than a practical application of the idea." Claims 16 and 19 have been amended to better define the claimed invention. Claim 22 is also amended to be consistent with amended claim 16.

Claims 19-20 are rejected because the Office Action alleges that the claims are directed to the claiming of a carrier wave. Applicants respectfully submit that claims 19 and 20, as amended, are directed to a computer-readable medium having codes that enable a computer to perform the recited functions. The claims are not directed to "a carrier wave." In fact, the specification teaches:

"The computer readable medium 500 may be any known medium, including optical discs, magnetic discs, hard discs, and other storage devices known to those of skill in the art. **Alternatively**, the programming required to implement the user-defined tunable may be provided **using a carrier wave** over a communications network such as the Internet, for example." (page 6, lines 29-33).

It is clear from this description that the "carrier wave" is not a form of "computer readable medium 500." The "carrier wave" is simply offered as an alternative to the computer readable medium 500.

Taken together, Applicants respectfully submit that the grounds for the rejection under 35 U.S.C. § 101 have been obviated. Withdrawal of the rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. § 112

Claim 22 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for reasons stated on page 3 of the Office Action. Specifically, the Office Action alleges that the claim “the save option being a hold until next boot option” is unclear. Applicants respectfully submit that the cited feature is described in the specification on page 4, line 29 (-d flag), on page 5, lines 10-11, and on page 6, line 13. Accordingly, the claim “the save option being a hold until next boot option” is properly supported by the specification.

Claims 2, 8, 16 and 19 stand rejected under 35 U.S.C. § 112, second paragraph, for using the trademark “UNIX[®]” as a limitation. Claims 1, 8, 12, 15, 16, and 19 have been amended to delete the trademark “UNIX[®]” from the claim language.

The Office Action also alleges that there is insufficient antecedent basis for the limitation “does not control any kernel resource directly” in Claim 21. Applicants respectfully submit that the limitation “does not control any kernel resource directly” is a new limitation for “the user-defined tunable” which has antecedent basis in claim 1. The new limitation itself does not require any antecedent basis.

Applicants respectfully submit that the grounds for the rejections under 35 U.S.C. § 112 have been obviated. Withdrawal of the rejections is respectfully requested.

Claim Rejection Under 35 U.S.C. § 102

Claim 1 stands rejected under 35 U.S.C. §102(a) as being anticipated by Nemeth et al. (hereinafter “Nemeth”) for reasons stated on page 4 of the Office Action. Applicants respectfully traverse the rejection.

For anticipation under 35 U.S.C. §102, the reference “must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.” (MPEP §706.02, IV. Distinction between 35 U.S.C. 102 and 103, page 700-21). The Federal Circuit has held that prior art is anticipatory only if every element of the claimed invention is disclosed in a single item of prior art in the form literally defined in the claim (*Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, (Fed. Cir. 1985); *Atlas Powder Co. v. DuPont*; 750 F.2d 1569, (Fed. Cir. 1984); *American Hospital Suppl v. Travenol Labs*, 745 F.2d 1 (Fed. Cir. 1984).

Nemeth generally describes the creation of drivers and the kernel in the Linux environment. As admitted by the Office Action, Nemeth does not teach that the newly created

kernel module included “expressions that relate one or more kernel tunables to the user-defined tunable, each of the kernel tunables being created by a developer and the user-defined tunable being created by a system administrator, each of the kernel tunables having a parameter value defined by an expression, wherein a change to the assigned value of the user-defined tunable changes the parameter value of each of the kernel tunables,” as recited in claim 1. The Office Action, however, alleges that “this feature is deemed to be inherent to the Nemeth system.” Applicants respectfully disagree.

First, Nemeth does not inherently teach “user-defined tunable being created by a system administrator.” Although Nemeth notes that “the availability of source code makes it easy, relatively speaking, to roll your own device drivers and kernel modules from scratch,” Nemeth also notes that

Today, Linux is so pervasive that sysadmins can be perfectly effective without ever getting their hands soiled with gooey kernel code. In fact, one might argue that such activities are better left to programmers and that administrators should focus more on the overall needs of the user community. System administrators can tune the kernel or add preexisting modules as described in this chapter, but they don't need to take a crash course in C or 80x86 assembly language programming to survive (Nemeth, page 220, the second paragraph).

It is thus clear that Nemeth does not require a system administrator to create a user-defined tunable. In fact, Nemeth argues against this approach. Applicants would like to bring to the Examiner's attention that inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See e.g., *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). The allegedly inherent characteristic must necessarily flow from the teachings of the applied prior art. See e.g., *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), see also *MPEP* §2112 IV.

Moreover, Nemeth does not inherently teach “expressions that relate one or more kernel tunables to the user-defined tunable.... each of the kernel tunables having a parameter value defined by an expression, wherein a change to the assigned value of the user-defined tunable changes the parameter value of each of the kernel tunables.” While it is possible that each tunable kernel in the Nemeth system may have at least one tunable parameter which can be expressed in term of one or more kernel tunables, it is not an absolute requirement. In

other words, the allegedly inherent characteristic does not necessarily flow from the teachings of the applied prior art.

Therefore, Applicants respectfully submit that Nemeth does not anticipate claim 1 because Nemeth fails to inherently teach ever aspect of the claimed invention. Withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(a) is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-6 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fiamingo in view of Nemeth for reasons stated on pages 5-7 of the Office Action. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fiamingo/Nemeth in view of U.S. Patent No. 6,272,519 to Shearer et al., (hereinafter "Shearer") for reasons stated on pages 7-8 of the Office Action. Claims 8-10 and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Compaq "Writing Kernel Module" True UNIX Version 5.1 or higher, August 2000 (hereinafter "Compaq") in view of Nemeth for reasons stated on pages 8-9 of the Office Action. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Compaq/Nemeth in view of Fiamingo for reasons stated on page 10 of the Office Action. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Compaq/Fiamingo/Nemeth in view of Shearer for reasons stated on page 10 of the Office Action. Claims 16-20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nemeth in view of Fiamingo for reasons stated on pages 10-11 of the Office Action. Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nemeth and Fiamingo in view of U.S. Patent Application Publication No. 20020023211 to Roth et al. (hereinafter "Roth") for reasons stated on page 12 of the Office Action. Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) and *MPEP* §2142. In order to combine references, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986).

Independent claims 1, 8, 16 and 19 of the instant application recite user tunables created by a system administrator. As discussed above, Nemeth does not teach or suggest creating user-defined tunables by a system administrator. In fact, Nemeth suggests that "such activities are better left to programmers and that administrators should focus more on the overall needs of the user community." (Nemeth, page 220, the second paragraph). Fiamingo, Shearer, Compaq, and Roth do not cure the deficiency of Nemeth.

Fiamingo describes tuning kernel parameters. As admitted by the Examiner, Fiamingo does not teach user tunables created by a system administrator.

Shearer describes a method to dynamically alter the availability or characteristics of specified system resources. Compaq describes how to write kernel modules. Roth describes a method and apparatus to configure a UNIX operating system without rebooting the system. None of these references teaches or suggests user tunables created by a system administrator.

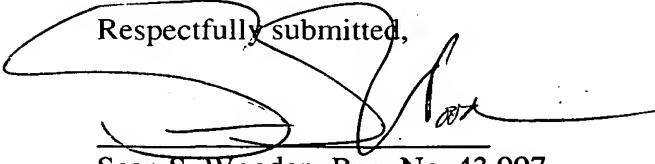
Accordingly, Applicants respectfully submit that Nemeth, Fiamingo, Shearer, Compaq, and Roth, individually or in combination, do not render claims 1, 8, 16 and 19 obvious. Applicants further submit that claims 2-7, 9-15, 17, 18, and 20-22 are allowable at least because they depend from one of claims 1, 8, 16 and 19 and for the additional features they recite. Withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested.

In view of the above remarks, Applicants respectfully submit that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

Date: September 6, 2006


Sean S. Wooden, Reg. No. 43,997
ANDREWS KURTH LLP
1350 I Street, NW
Suite 1100
Washington, DC 20005
Tel. (202) 662-2700
Fax (202) 662-2739